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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,646	02/18/2004	Craig Ullman	559442000225	1340
25227	7590	06/24/2005	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 300 MCLEAN, VA 22102			VU, VIET DUY	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,646

Applicant(s)

ULLMAN ET AL

Examiner

Viet Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-137 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-137 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/18/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Art Rejections:

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-18, 21-27, 31, 44-61, 64-70, 74-75, 88-105, 108-114, 118 and 131-137 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Schein et al, U.S. pat. No. 6,002,394.

Per claims 1, 3-5 and 31, Schein discloses a system and method for providing media/broadcast programming and online services to user comprising:

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- a) generating and providing broadcast programming via broadcast communication medium (see col 6, lines 37-45),
- b) generating online content, the online content is intended to be presented automatically at a user device concurrently with the programming, i.e., ads, information on products, programs, or artists, etc., for displaying at predetermined time (see col 7, lines 16-64, col 14, lines 18-67, col 15, line 58 - col 16, line 14 and col 20, lines 18-63),
- c) selecting at least one address identifying the online content (see col 13, lines 58-66 and col 18, lines 20-43),
- d) storing and transmitting the programs and online addresses in a storage including VCR, DVD, computer memory, radio, satellite, cable, fiber optics, etc. (col 5, lines 45-65 and col 12, lines 61-64).

Per claims 2 and 21, Schein teaches providing timing data (time slots) within the program schedule such that each program and other related data can be displayed/viewed in a predetermined timing order (see col 9, lines 29-37).

Per claims 6-18 and 22-27, it is noted that Schein's teachings are applicable to all conventional broadcast programs and all known online content formats.

Claims 44-61, 64-70, 74-75, 88-105, 108-114, 118 and 131-137 are of the same scope as that of claims 1-18, 21-27 and 31,

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i.e., corresponding apparatus and computer program claims, and hence are also anticipated by Schein's teachings.

3. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 19, 62 and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein.

Schein's teachings are still applied as discussed in item 4 above. Schein does not teach storing addresses at the server in a link file to be downloaded to the users.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to envision any conventional ways to store and transmit a group of addresses to user including individual transmission or in a link file. Sending a group of addresses together in a file would have been motivated because it would have reduced the transmission time.

6. Claims 20, 28-30, 32-43, 63, 71-73, 76-87, 107, 115-117 and 119-130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein and further in view of Dedrick, U.S. pat. No. 5,710,884.

Schein does not teach maintaining a user profile and monitoring user's activity during the program duration. The use of such user profile and/or user activity monitoring for marketing purposes is well known in the art as disclosed by Dedrick (see Dedrick in col 5, lines 17-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein with Dedrick's teaching because it would have enabled the server to compile a user profile for use by the advertisers.

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Conclusion:

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on 571-272-3964.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIET D. VU
PRIMARY EXAMINER

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6/21/05